



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte JAY PAUL DRUMMOND et al.

Appeal No. 2003-1651
Application No. 09/193,787¹

ON BRIEF

Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.
NAS^E, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection (Paper No. 18, mailed September 16, 2002) of claims 1 to 30, which are all of the claims pending in this application. On page 2 of the reply brief (Paper No. 22, filed April 18, 2003), the appellants noted that (1) they are willing to amend dependent claim 27 to include mutually agreeable language in order to overcome the sole rejection of claim 27 as

¹ Filed November 17, 1998. According to the appellants, the application claims benefit of provisional Application No. 60/031,856, filed November 27, 1996.

being indefinite under the second paragraph of 35 U.S.C. § 112; and (2) the rejection of claim 27 no longer appears to be an issue. Accordingly, we deem the appeal with respect to claim 27 to be withdrawn and we dismiss the appeal with respect to claim 27. Claims 1 to 26 and 28 to 30 remain on appeal.

We REVERSE.

BACKGROUND

The appellants' invention relates to automated banking machines (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The references of record relied upon by the examiner in rejecting the appealed claims are:

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|--------------------------|------------------------|---------------|
| McLean | 4,337,864 | July 6, 1982 |
| McMillan | 5,436,435 | July 25, 1995 |
| Russell et al. (Russell) | 5,905,248 | May 18, 1999 |
| Zeanah et al. (Zeanah) | 5,933,816 ² | Aug. 3, 1999 |

² This patent issued from Application No. 08/908,413, filed August 7, 1997. This patent claims benefit of provisional Application No. 60/029,209, filed October 31, 1996.

Claims 1 to 6, 8-13, 16 and 22 to 26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Zeanah.

Claims 7, 14, 28 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zeanah in view of Russell.

Claim 29 stands rejected under 35 U.S.C. § 103 as being unpatentable over Zeanah in view of Russell and McLean.

Claims 15 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zeanah in view of McLean.

Claims 18 to 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zeanah in view of McMillan.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 21, mailed March 11, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 20, filed January 17, 2003) and

reply brief (Paper No. 22, filed April 18, 2003) for the appellants' arguments thereagainst.

OPINION

The appellants assert (brief, pp. 11-24) that (1) Zeanah is not available as prior art under 35 U.S.C. § 102(e); and (2) the 37 CFR § 1.131 declaration of Jay Paul Drummond (Paper No. 13, filed February 4, 2002) is sufficient to overcome the prior art rejections under appeal. We agree.

The burden of establishing a prima facie case of anticipation resides with the examiner. See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Likewise, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

It is the examiner's burden to establish that Zeanah is available as prior art under 35 U.S.C. § 102(e)³ with respect to the claims under appeal. This the examiner has not done.

³ 35 U.S.C. § 102(e) provides that a person shall be entitled to a patent unless the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent.

To establish that Zeanah is available as prior art under 35 U.S.C. § 102(e) with respect to the claims under appeal, the examiner must determine that the effective filing date of Zeanah is prior to the effective filing date of the claimed subject matter. Thus, the examiner must determine the effective filing date of Zeanah and the effective filing date of the claimed subject matter.

Zeanah is clearly entitled to at least an effective filing date of August 7, 1997. Zeanah is not entitled to an effective filing date of October 31, 1996 unless the provisional application (Application No. 60/029,209) discloses the claimed invention in the manner required by the first paragraph of 35 U.S.C. § 112.⁴ The examiner has not determined that provisional Application No. 60/029,209 discloses the claimed invention in the manner required by the first paragraph of 35 U.S.C. § 112. Accordingly, for purposes of this appeal, the examiner has only determined that Zeanah is entitled to an effective filing date of August 7, 1997.⁵

The appellants claim benefit back to provisional Application No. 60/031,956, filed November 27, 1996. To apply Zeanah as prior art under 35 U.S.C. § 102(e), the

⁴ See 35 U.S.C. § 119(e).

⁵ The examiner's position (answer, pp. 14-15) that due to the presumption of validity the patent to Zeanah is presumed to be entitled to the October 31, 1996 filing date of the provisional application is without merit.

examiner must also determine the effective filing date of the claimed subject matter (e.g., is the claimed subject matter entitled to an effective filing date of November 27, 1996). The examiner has not set forth the effective filing date of the claimed subject matter.⁶

Since the examiner has not established that the effective filing date of Zeanah is prior to the effective filing date of the claimed subject matter, the examiner has not established that Zeanah is available as prior art under 35 U.S.C. § 102(e).

In any event, even if Zeanah was available as prior art under 35 U.S.C. § 102(e) with an effective filing date of October 31, 1996, the appellants submit that the Drummond declaration establishes reduction to practice of the subject matter of claims 1-4, 6-19 and 22-27 prior to July 7, 1996, thus overcoming the prior art rejections of claims 1-4, 6-19 and 22-27. The appellants admit (brief, p. 15) that the differences between claims 5, 20, 21 and 28 to 30 and claims 1-4, 6-19 and 22-27 would have been obvious to one of ordinary skill in the art. Thus, the appellants argue that the prior art rejections of claims 5, 20, 21 and 28 to 30 is also overcome by the Drummond declaration.

⁶ The appellants assert that the effective filing date of the claimed subject matter is November 27, 1996.

The examiner's sole expressed objection to accepting the Drummond declaration (answer, pp. 17-18) is that it is not signed by all the joint inventors of the claims under rejection (i.e., claims 1 to 26 and 28 to 30). However, this objection is not a proper basis for refusing to accept the Drummond declaration since that declaration is signed by the inventor of the subject matter of claims 1 to 4, 6 to 19 and 22 to 27). 37 CFR § 1.131 permits such a declaration to be signed by less than all of the inventors.

Since the examiner has not proffered any valid objection as to why the Drummond declaration does not establish a reduction to practice of the subject matter of claims 1-4, 6-19 and 22-27 prior to July 7, 1996, the Drummond declaration must be accepted by us as sufficient to overcome the prior art rejections under appeal.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 6, 8-13, 16 and 22 to 26 under 35 U.S.C. § 102(e) is reversed and the decision of the examiner to reject claims 7, 14, 15, 17 to 21 and 28 to 30 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 6, 8-13, 16 and 22 to 26 under 35 U.S.C. § 102(e) is reversed and the decision of the examiner to reject claims 7, 14, 15, 17 to 21 and 28 to 30 under 35 U.S.C. § 103 is reversed.

REVERSED


NEAL E. ABRAMS
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

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Appeal No. 2003-1651
Application No. 09/193,787

Page 9

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